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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

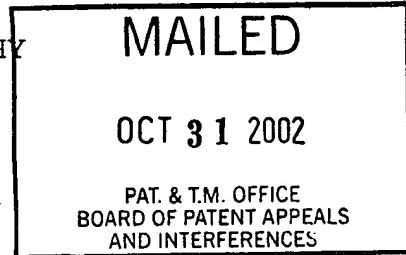
Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID G. McCARTHY

Appeal No. 2001-0076
Application 08/951,276¹



ON BRIEF

Before BARRETT, GROSS, and LEVY, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-20.

We reverse.

¹ Application for patent filed October 16, 1997, entitled "Retractable Receptacle for Furniture."

BACKGROUND

The invention relates to a retractable receptacle for electronic or communications equipment mounted in a furniture unit, such as office conference tables.

No prior art is relied on in the rejection.

Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph, based on a lack of written description. The statement of the final rejection is as follows (Paper No. 8, p. 3):

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is a lack of written description for the following; "means for coupling said housing", *means for resiliently biasing*; "means" for selectively displacing the receptacle unit; the "open top" of the housing; means for biasing the receptacle unit, locking means. And it is also unclear how the covering means are mounted to the top of the receptacle unit and carried by the receptacle unit as it is being displaced.

The rejections under 35 U.S.C. §§ 102 and 103 have been withdrawn.

We refer to the final rejection (Paper No. 8) (pages referred to as "FR_{__}") and the examiner's answer (Paper No. 13) (pages referred to as "EA_{__}") for a statement of the examiner's position, and to the reply brief (Paper No. 14) (pages referred to as "RBr_{__}") for a statement of appellant's arguments thereagainst.

OPINION

The examiner states in the examiner's answer that the rejection is based on a lack of written description under 35 U.S.C. § 112, first paragraph, not on a lack of enablement (EA3). For this reason, appellant's arguments in the appeal brief (Paper No. 12) to enablement are moot and we refer to the written description arguments in the reply brief (Paper No. 14). However, we note that appellant was correct in interpreting the examiner's rejection as based on lack of enablement instead of lack of written description. The statement of the rejection, that the claims contain "subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention" (FR3), is clearly directed to lack of enablement, as evidenced by the words "enable" and "make and/or use the invention." The reference to "written description" after the statement of the rejection can be interpreted to refer to an insufficient written description to enable the person of ordinary skill in the art to make and use the invention and does not recast the statement of the rejection into one based on a lack of written description. If the examiner had been more careful in stating the rejection, appellant could have responded to the rejection in the brief and would not have

been put to the time and expense of writing a reply brief and, perhaps, this appeal would have been avoided altogether.

The written description rejection under 35 U.S.C. § 112, first paragraph, is used to reject when a claim is amended to recite elements thought to be without support in the original disclosure. In re Rasmussen, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (CCPA 1981). "Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 UPSQ2d 1111, 1115 (Fed. Cir. 1991), citing In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 623 (CCPA 1973).

It would have been helpful if the examiner's statement of the rejection had pointed to the claims in which the limitations which are said to be without written description support are contained. We agree with appellant's discussion (RBr3) that the "means for coupling said housing" in the rejection must be intended to refer to "said housing includes means for coupling said receptacle unit to an external power source" in claim 20. The "means for resiliently biasing" and "means for biasing the receptacle unit" in the rejection must both refer to the "means for resiliently biasing said receptacle unit" in claim 6. The

"'means' for selectively displacing the receptacle unit" in the rejection must refer to the "means for selectively displacing said receptacle unit" in claims 1, 16, and 19. The "'open top' of the housing" in the rejection must refer to "a housing . . . , said housing having an open top" in claim 19. The "locking means" in the rejection must refer to the "cooperating releasable locking means" in claim 6.

Appellant shows exactly where the disputed limitations are supported in the specification (RBr3-4). We completely agree with appellant. Moreover, there is absolutely no basis for a lack of written description rejection since each of these limitations was in the originally filed claims. We are not prescient and do not know whether the examiner had some other, unexplained, rationale for rejecting the claims.² Thus, the

² We might guess that the examiner bases the rejection on a lack of written description of structure supporting the "means" limitations, except that not all of the noted limitations are in "means" format. To the extent this is the examiner's unexpressed rationale, we note that 35 U.S.C. § 112, sixth paragraph, recites that mean-plus-function language "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof" (emphasis added). "The emphasized language does not add any additional description requirement to that set forth in the first paragraph of the section." In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973); In re Comstock, 481 F.2d 905, 908, 178 USPQ 616, 618 (CCPA 1973) (As indicated in Knowlton, "the third [now sixth] paragraph of § 112 does not impose a separate requirement that an invention claimed in 'means-plus-function' form must be described apart from the description requirement expressed in the first paragraph of that section."). The Federal Circuit's decision in In re Dossel, 115 F.3d 942, 42 USPQ2d 1881 (Fed. Cir. 1997) does not address these cases.

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rejection of claims 1-20 based on lack of written description for these limitations is reversed.

The rejection further states (FR3): "it is also unclear how the covering means are mounted to the top of the receptacle unit and carried by the receptacle unit as it is being displaced." This does not appear to be a written description rejection because it questions "how" something is done and we do not find where "covering means" are claimed. This statement is not addressed by appellant. Nevertheless, the rejection is without merit. To the extent the examiner is referring to "said receptacle unit having a top," as recited, for example, in claim 1, this was part of originally filed claim 1 and cannot lack written description. The rejection of claims 1-20 based on lack of written description for this reason is reversed.

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CONCLUSION

The rejection of claims 1-20 is reversed.

REVERSED

Lee E. Barrett
LEE E. BARRETT

LEE E. BARRETT
Administrative Patent Judge

Anita Pelman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

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Administrative Patent Judge

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